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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,186	04/19/2001	Matthew L. Meyerson	7032/2002	1540
29933	7590	07/16/2004		
PALMER & DODGE, LLP KATHLEEN M. WILLIAMS 111 HUNTINGTON AVENUE BOSTON, MA 02199			EXAMINER ALLEN, MARIANNE P	
			ART UNIT 1631	PAPER NUMBER

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

MS
Advisory Action

Application No.

09/839,186

Applicant(s)

MEYERSON, MATTHEW L.

Examiner

Marianne P. Allen

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-26,29-31,50,51,53-58 and 60-64.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: _____

Marianne P. Allen
Marianne P. Allen
Primary Examiner
Art Unit: 1631

7/15/04

Continuation of 2. NOTE: The proposed amendments substantively amend the claims and would require further search and consideration with respect to applicable prior art and enablement. Note that the goal of the method has changed significantly and no longer requires determining the presence of a microbe in a host organism (see independent claims). In addition, the proposed claims introduce or do not overcome 112, 2nd paragraph issues. For example, claim 4 compares the candidate sequence to a database of microbial sequences and concludes that the presence of the candidate sequence identifies a symbiotic microbial organism; however, the database in question does not need to be from a symbiotic microbial organism. It could contain sequences from a pathogenic microorganism or include multiple microorganisms. See also claims 5-6. For example, claim 8 continues to require pre-knowledge of the microbe in the host organism as being an intracellular pathogen before the method is executed. For example, claim 17 states that the host organism is a microorganism yet the preambles of claims 1, 2, and 3 specifically exclude microbial host organisms.

Continuation of 3. Applicant's reply has overcome the following rejection(s): Basis is seen for the limitation "20 consecutive nucleotides" and would overcome the portion of the enablement rejection concerning matching.